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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/056,894      | 11/13/2001  | Jurgen Bussert       | 071308.0249         | 1763             |

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| EXAMINER |
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STORK, KYLE R

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| ART UNIT | PAPER NUMBER |
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2178

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                       |  |
|------------------------------|--------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/056,894 | <b>Applicant(s)</b><br>BUSSERT ET AL. |  |
|                              | <b>Examiner</b><br>Kyle R Stork      | <b>Art Unit</b><br>2178               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>13 November 2001</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is in response to the application filed 13 November 2001 and the Information Disclosure Statement filed 13 November 2001.
2. Claims 1-12 are pending. Claims 1, 6, and 8 are independent claims.

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "project data and/or project planning data" embodiments of claim 1 must be shown or the feature(s) canceled from the claim(s). This requires showing the embodiment with only project data, the embodiment with only project planning data, and the embodiment with both project data and project planning data. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement

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Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

4. Claim 9 objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 11 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. The term "according to claim 1" in claim 11 is a relative term which renders the claim indefinite. The term "according to claim 1" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is not possible for one of ordinary skill in the art to determine the requisite degree that must be met for the method to fit this standard.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 4-9, and 11-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Alam et al. (US 6336124, 2002).

As per independent claim 1, Alam discloses a device for converting data from a proprietary format in an automation project or component to a format defined by a standard meta format, comprising:

- A conversion apparatus (Figure 5; column 2, lines 12-14)
- A means for converting the data with a defined format into project data and/or project planning data with a proprietary format (Figure 5; column 2, lines 1-11 and lines 28-26: Here, Microsoft® Word, Word Perfect™, Autocad™, and Microsoft® PowerPoint are all proprietary formats)
- Means for providing the data with a format for further processing (column 2, lines 1-12 and lines 28-36: Here, several document formats, including XML, HTML, CSS, and Autocad™ are able to be processed)

As per dependent claim 4, Alam discloses the device further comprising a data storage apparatus for storing the data with a defined format (Figure 2, item 155; column 2, lines 63-67).

As per dependent claim 5, Alam disclose an engineering system comprising the device according to claim 1 (Figure 5; column 2, lines 1-14 and lines 28-36).

As per independent claim 6, the applicant discloses a method for execution of claim 1. Claim 6 is thusly rejected under Alam for reciting limitations similar to those in claim 1.

As per dependent claim 7 Alam discloses the method further comprising reading-in and processing the data with a defined format by at least one software program product or tool (Figure 5).

As per independent claim 8, the applicant discloses a method for execution of claim 1. Claim 8 is thusly rejected under Alam for reciting limitations similar to those in claim 1.

As per dependent claim 9, Alam discloses the device further comprising a data storage apparatus for storing the data with a defined format (Figure 2, item 155; column 2, lines 63-67).

As per dependent claim 11, Alam discloses the method further comprsing exporting data with a defined format from the software program product or tool into a device (Figure 5; column 2, lines 1-14 and lines 28-36: Here, all of these formats have a defined format).

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As per dependent claim 12, the applicant discloses a method for execution of claim 1. Claim 12 is thusly rejected under Alam for reciting limitations similar to those in claim 1.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 2-3 and 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Alam in further view of AutoCAD Release 12 (Release 12 June 1992).

As per dependent claim 2, Alam discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Alam fails to specifically disclose the device further comprising an export/import apparatus. AutoCAD discloses an export/import apparatus (page 4, paragraphs 4-5).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Alam's device for conversion with AutoCAD's device for export/import, since it would have allowed a user to import files of one type and export them as another type.

As per dependent claim 3, Alam discloses the limitations similar to those in claim 2, and the same rejection is incorporated herein. Alam fails to disclose the

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export/import apparatus embedded in a single apparatus. AutoCAD discloses the export/import apparatus embedded in a single apparatus (page 4, paragraph 4-5).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Alam's device for conversion with AutoCAD's device for export/import into a single apparatus, since it would have allowed a user to import files of one type and export them as another type.

As per dependent claim 10, Alam discloses the limitations similar to those in claim 7, and the same rejection is incorporated herein. Alam fails to specifically disclose the method wherein the software program product or tool is selected from a version administration tool, a CAD, CAM, CAE program, a cam disk tool, a productivity program, or a project design tool. AutoCAD discloses the method wherein the software program product or tool is selected from a version administration tool, a CAD, CAM, CAE program, a cam disk tool, a productivity program, or a project design tool (pages 1-5).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Alam's method of reading-in and processing with AutoCAD's method of being a CAD, CAM, CAE program, a cam disk tool, a productivity program, or a project design tool, since it would have allowed a user to perform a variety of operation on the data (AutoCAD: pages 1-5).

### ***Conclusion***



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12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US006542901B1 Devine et al.: Discloses formatting data files.
- US006490603B1 Keenan et al.: Discloses producing a structured format.
- US006157924A Autstin: Discloses delivering information.
- US006119137A Smith et al.: Discloses document conversion.
- US006085199A Rose: Discloses distributing a file in a plurality of formats.
- US005848386A Motoyama: Discloses translating documents.
- US005826062A Fake, Jr. et al.: Discloses converting and display of multimedia documents.
- US005504891A Motoyama et al.: Discloses format conversion.
- US005173853A Kelly et al.: Discloses data format conversion.
- US20020002566A1 Gajraj: Discloses transformation of marked up documents.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R Stork whose telephone number is (571) 272-4130. The examiner can normally be reached on Monday-Friday (7:00-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (703) 308-5465. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kyle Stork  
Patent Examiner  
Art Unit 2178



STEPHEN S. HONG  
PRIMARY EXAMINER